

### **REMARKS**

The Applicant appreciates the Examiner's thorough review of the Application and withdrawal of the previous rejections. Reconsideration and allowance of all claims as amended are respectfully requested.

No new matter has been added by the amendments. Although Applicant disagrees with the rejection of record for reasons including those discussed below, in the interest of expediting prosecution Claims 1 and 6 have been amended to incorporate the subject matter of claims 2 and 7, respectively, which are now canceled, and to clarify that the projections are movable in the longitudinal direction of the strengthening rod, as shown in Figures 4a-4b and as described in the accompanying text of the Specification. Claim 11 has been amended to incorporate this subject matter from claims 1 and 6. Claims 5, 9 and 13 have been amended to clarify that the force generating member need not be a coiled spring, as supported for example by canceled claim 7, which taught a spring force but not a coiled spring, and at Page 3, second paragraph of the Specification ("the said projections are movable against a spring force"). New claims 15 – 17 incorporate the canceled subject matter of claims 5, 9, and 13.

Claims 1, 3 – 6, and 8 – 15 are now pending in the application, including independent Claims 1, 6, and 11.

**Claims 1 - 14 are patentable under 35 U.S.C. 103(a) over Hanright (U.S. Patent 5,988,254) in view of White (U.S. Patent 2,689,349).**

The present application teaches a closing sleeve for tunnels of folding curtains that attaches to strengthening rods in those tunnels. At the other end of the strengthening rod the tunnel may be sewn closed. The closing sleeve has pointed projections at one end that prick through the wall of the tunnel towards the end of the tunnel and exert force on it, stretching and closing it. These projections are

movable in the longitudinal direction of the strengthening rod against a spring force. This creates a constant tension on the curtains, giving them a nice and straight aspect, and allows for easy removal of the closing sleeve from the curtain by insertion of a narrow object such as a toothpick between the sides of the closed tunnel. The inserted object pushes the pointed projections into a second position where they do not push through the wall of the tunnel, opening the tunnel for easy removal.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

#### The References Do Not Teach or Suggest All the Claim Limitations

Independent Claims 6 and 11 as amended are distinguished from the references at least in that they teach a strengthening rod comprising a number of pointed projections at least at one extremity and that the said projections are pricking through the wall of the tunnel in order to close the tunnel, wherein the said projections are movable in the longitudinal direction of the strengthening rod against a spring force.

The references, taken alone or in combination, do not teach or suggest this limitation. The Examiner argues that Hanright teaches strengthening rods in curtain tunnels, but allows that Hanright does not teach or suggest pointed projections of any kind. The Examiner therefore relies on White to teach the remaining elements.

The Examiner argues that White teaches pointed projections 19 pricking through the wall of a material that are movable against a spring force and part of a "terminal (12)(10)(8) element provided on

the rod." However, the piercing points of White are not part of an extremity of a strengthening rod as described in the specification of the present application, nor does the Examiner give any explanation as to how the features of White could be incorporated into Hanright.

The Examiner has already cited to Hanright as teaching a strengthening rod. White does not teach anything similar to a strengthening rod. It is unclear how the argued strengthening rod of Hanright could be combined with any of the features of White. White does not deal with an easily removable stiffener in a tunnel-like or pocket-like fabric section, see Figure 3. White is for straightening a collar or other flat piece of fabric and no reason or method is given for using White in a tunnel or pocket.

Furthermore, the Examiner does not argue that the references taken alone or in combination would supply the limitation of Claims 6 and 11 as amended that the said projections are movable against a spring force in the longitudinal direction of the strengthening rod. Indeed, in order to straighten the fabric of the pockets of Hanright so that they would close, the piercing points of White would have to move in a direction perpendicular to the longitudinal axis of rod 3 of Hanright.

This is an important distinction. This longitudinal movement generates the tension that gives the curtains their straight aspect and allows for easy removal of the strengthening rod using a narrow object. It is a major object of the invention to provide an easily removable spring loaded stiffening and stretching bar from its position in a fabric tunnel (or pocket) in a folding curtain. In contrast, were the device of White used to close the tunnel of a curtain, removal of the device and/or any strengthening rod would be very difficult, requiring fingers to be forced into a closed tunnel in order to compress the device and remove the piercing points from the tunnel wall. Damage to the curtain might well result.

Therefore, the references, taken alone or in combination, do not teach or suggest all the limitations of claims 6 and 11. Claims 8 – 10 and 12 – 14 depend from patentable claim 6 or 11 and share their patentable limitations and add further patentable features. For example, claims 8 and 12 add

that the projections are part of a terminal element provided on the strengthening rod. No references, taken alone or in combination, teach or suggest this feature. Although the Examiner argues that White teaches this feature, elements 8, 10, and 12 cited to by the Examiner are not terminal elements on a strengthening rod.

Claims 9 and 13 add that the terminal element comprises a sleeve-shaped jacket containing a force generating member and an element provided with the said pointed projections and the element is movable against the spring force of the force generating member. Claim 13 further specifies that the element is movable from a first to a second position, the element in its second position being situated within the space surrounded by the sleeve-shaped jacket. No references, taken alone or in combination, teach or suggest these features. Although the Examiner argues that White teaches a terminal element comprising a sleeve shaped jacket 10 containing a coiled spring 8 and an element provided with pointed projections 19, where the element is movable against the spring force of the coiled spring, Applicant respectfully disagrees.

Element 10 of White is an eye on an elongated shank portion 9 of wires 6 and 7, through which the opposing wire 6 or 7 is inserted. An eye is not a sleeve shaped jacket. It furthermore does not contain a coiled spring or pointed projections. A comparison of the figures of the present invention with White illustrates the differences between the structures. The Examiner does not argue that the references teach the element in its second position being situated within the space surrounded by the sleeve-shaped jacket. Applicant believes that the references do not teach or suggest such a limitation.

Claim 8 depends from independent and patentable Claim 6, discussed above. The Examiner argues about a limitation of "wherein the projections are made of synthetic material," however no such limitation is found in Claim 8. Applicant believes that the Examiner is referring to Claim 10, which also depends from and shares the patentable limitations of independent Claim 6 and for at least that reason is patentable as well.

Independent Claim 1 is distinguished from Hoyt at least in that it teaches a strengthening rod is provided in the tunnel, comprising at least at one extremity a number of pointed projections, and the tunnel is closed by pricking the said projections through the wall of the tunnel, wherein the said projections are movable in the longitudinal direction of the strengthening rod against a spring force.

For reasons analogous to those discussed above, the references, taken alone or in combination, do not teach or suggest these claim limitations. Claims 2 - 5 depend from Claim 1 and add further patentable limitations similar to those discussed with regard to independent claims 6 and 11 above.

Although the Examiner states at paragraph 4 at page 4 of the latest Office Action with respect to the pending method claims 1-5 that "Hanright ... obviously discloses said method," Applicant believes the Examiner intended to state that he considers these claims obvious over Hanright in view of White. Otherwise, this comment appears to be contradicted by the statements in paragraph 3, beginning at the bottom of page 3 of the latest Office Action, describing the elements which Hanright fails to disclose.

Hanright only discloses with reference to its figs. 9 and 10 stiffeners (2, 3) in the form of a telescopic pole 30 (sections 31 and 33) to accommodate windows (curtains) of varying widths. See col. 6, l. 12-19 and l. 25-63. With the spring biased pushbutton 32 no spring force is generated in the longitudinal direction of the stiffeners but only in the cross direction. The pole ends do not carry pointed projections (that moreover prick through the wall of the tunnel). They are not spring loaded in their longitudinal direction and thus they do not stretch up the curtain under a horizontal tension. In col. 6, l. 64 to col. 7, l. 9 the patent even teaches the contrary and thus away from such tension, thus resulting in a rather ruffled appearance for the curtain (see also fig. 11).

For at least the above reasons, Hanright and White, taken alone or in combination, do not teach or suggest all the limitations of claims 1 - 6 and 8 - 14. Furthermore, there would be no motivation to combine Hanright and White.

No Motivation or Suggestion for Combination

MPEP §2141 states "the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis. The *Graham* factors were reaffirmed and relied upon by the Supreme Court in its consideration and determination of obviousness in the fact situation presented in *KSR*." MPEP §2141 further states "The factual inquiries... are as follows: (A) Determining the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art." It is respectfully submitted that the November 14, 2008 Office Action does not comply with Office policy at least in that it lacks a resolution of the level of ordinary skill in the pertinent art.

MPEP §2141.02 also states "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02 further states "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (Emphasis in original)

It is respectfully submitted that the Office Action of November 14, 2008, does not consider the prior art or references as a whole and does not consider the claimed invention as a whole, without the benefit of impermissible hindsight. Hanright teaches a washable window shade with readily removable non-washable components. Stiffener members provided on the main shade member maintain it flat and are either removable or washable. (Abstract) One end of each elongated pocket in which the stiffener members are placed is provided with closure means such as a snap closure or Velcro® type closure for removal of the stiffener. (Col. 3, lines 59-66)

In contrast, White is a stiffening and stretching device for applying to a piece of fabric such as a shirt collar for retaining the fabric in a stretched condition, preventing folding or wrinkling of the

collar. (Abstract) The device has a tapered piercing point 19 on either end of sections of stiff wire joined by a spring connection. The sections are squeezed inwards, compressing the spring, the piercing points are inserted into the collar, and when released the spring pushes the sections away from one another, forcing the piercing points into the collar and stretching it. It is not arranged in a tunnel-like or pocket-like fabric, from which it would be difficult to remove.

These are two completely different inventions with different purposes. White is a fabric stiffening and stretching device for shirt collars and Hanright is a washable window shade having elongated pockets with snap or Velcro® closures. There is no relation between the two. There would have been no motivation or suggestion to one of ordinary skill in the art to modify Hanright with any of the teachings of White.

The Examiner argues that "It would have been obvious to one having ordinary skill in the art at the time the invention was made to included the terminal element with pointed projections movable against a spring force as taught by White '349 in order to provide a means to retain the strengthening rod in a stretched condition against the fabric," citing to Column 1, lines 1-13. Applicant respectfully disagrees.

The Examiner refers to element 3 of Hanright as the strengthening rod. White does not retain element 3 of Hanright in a stretched condition against the fabric, nor could it. Applicant respectfully requests that the Examiner clarify his argument in this regard. Furthermore, any suggestion or motivation must come "from the references themselves or ... the knowledge generally available to one of ordinary skill in the art." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The motivation given by the Examiner does not appear anywhere in either reference.

In addition, citing to *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984), the Federal Circuit has pointed out that "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the

modification". In re Fritch, 23 USPQ2d 1783, 1784 (Fed. Cir. 1992). The motivation supplied by the Examiner does not appear to be desirable in any way.

MPEP 82141.02 teaches "A prior art reference must be considered in its entirety i.e. as a whole". Hanright teaches the use of closure means for each elongated pocket and would therefore have no need for a device such as Hanright in order to close the pockets. It is also unclear how Hanright could be modified to have the device of White attached to the ends of its rod 3. The devices do not appear to be compatible or to have any mechanism for their attachment or combination.

When the references are considered as a whole, they do not suggest the desirability and thus the obviousness of making the combination. Without a motivation for combining the references, there is no prima facie case of unpatentability and the claims must be allowed. The present invention, taken as a whole, would not be obvious from the references, taken as a whole. Only by relying on impermissible hindsight motivation found in the present Application could the references be combined to arrive at the claimed invention.


For at least the above reasons, the rejection of Claims 1 - 14 under 35 U.S.C. 103(a) over Hanright in view of White is improper and should be withdrawn.



## CONCLUSION

Reconsideration and allowance of all claims are respectfully requested.

Respectfully,



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